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This Opinion is Not  
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of the TTAB

Paper No. 14  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Parametric Technology Corporation

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Serial No. 78044413

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Thomas V. Smurzynski of Lahive & Cockfield, LLP for  
Parametric Technology Corporation.

Michael Webster, Trademark Examining Attorney, Law Office  
102 (Thomas Shaw, Managing Attorney).

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Before Seeherman, Walters and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Parametric Technology Corporation [applicant] has  
applied to register the mark WINDCHILL PROJECTLINK for  
various computer related products and services.

Specifically, the identification covers the following:

Computer software for computer aided design, CAD,  
for general use, computer-aided manufacturing,  
CAM, for general use, and computer aided  
engineering, CAE, for general use; computer  
software for workflow, process and production  
automation; computer software for visualization  
and digital mockup; computer software for

information management of business, organizational, supplier, engineering, component, product, production and maintenance information; computer software for use in software development, and accompanying user guides sold with such software as a unit, in International Class 9;

Computer education training services, namely, training and education services in the field of computer software, in International Class 41; and

Technical support services, namely, troubleshooting of computer software problems via telephone; updating of computer software; maintenance of computer software, namely, maintenance and error correction services for computer software; computer consultation; product development for others; repair of computer software, in International Class 42.

The application is based on applicant's stated bona fide intention to use the mark in commerce on or in connection with these identified products and services.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the prior registration of the mark PROJECTLINK for goods identified as "computer software program and accompanying user's manual used to generate and update project management plans from business and engineering models," in International Class 9.<sup>1</sup> When the refusal of registration was made final, applicant appealed. Applicant

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<sup>1</sup> Registration No. 2,212,382 issued December 22, 1998 to Knowledge Based Systems, Inc.

and the examining attorney have filed briefs, but applicant did not request an oral hearing.

Preliminary matters we must address are the questions of whether the examining attorney's refusal of registration was made as to all three classes in the application and, if so, whether the refusal was waived or withdrawn in the briefing of the appeal as to one or more classes. Thus, we examine the content of the office actions and responses, and the briefs, to find the answers to these questions.

In the initial office action, the examining attorney refused registration "because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in [the cited registrations<sup>2</sup>] as to be likely to cause confusion, mistake, or to deceive." Further, in discussing the marks, he stated that their similarities "are likely to cause confusion as to the origin of the goods." The examining attorney then went on to quote in full applicant's identification of goods, but not its services, to compare applicant's goods with the identification of goods in the cited registration, and to conclude "[t]he same consumers will be exposed to the goods

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<sup>2</sup> In that office action, the examining attorney also refused registration based on a registration for the mark WINDCHILL, but applicant acquired the company that owned that registration and the registration was assigned to applicant.

identified with each mark. The similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion." In short, the examining attorney made no mention whatsoever of applicant's services in connection with the refusal of registration.<sup>3</sup>

Applicant's response to the initial office action argued against the refusal of registration solely on the basis of asserted differences in the marks and on the basis that the registered mark should be accorded a narrow scope of protection.

In his second office action, which was denominated the final refusal of registration, the examining attorney recapped the refusal set forth in the initial action, stating "[r]egistration was refused... because the mark for which registration is sought so resembles the [marks in the cited registrations] as to be likely, when used on or in connection with the identified goods and services, to cause confusion, or to cause mistake, or to deceive." Also, the examining attorney repeated, verbatim, the following from the initial office action: "The same consumers will be exposed to the goods identified with each mark. The similarities among the marks and the goods of the parties

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<sup>3</sup> The examining attorney only mentioned the services insofar as he required amendment of the classification for one service.

are so great as to create a likelihood of confusion." In a request for reconsideration (applicant's "Response to Final Refusal"), applicant again argued the differences in the marks and that the cited PROJECTLINK mark should be accorded a narrow scope of protection. In denying the request for reconsideration, the examining attorney stated, in regard to the goods, "Applicant's computer software is very similar to registrant's."

In its main brief on appeal, applicant argued, "The software described in Applicant's application is not identical to that of the cited registration." Also, applicant argued, "The goods, software products are different, and any similarity is precisely in the area that the term 'Project Link' aptly describes. Both the marks and the goods of this application and of the cited registration are effectively different."

In his brief, the examining attorney stated that applicant had "applied to register the mark WINDCHILL PROJECTLINK for goods and services, including..." and then went on to quote only the Class 9 identification. Section two of the examining attorney's brief is entitled "Applicant's Computer Software and Registrant's Computer Software Are Used for Similar Functions in the Same Field." The examining attorney, in this section, states that

"[a]pplicant provides no evidence of a difference between its software and the software in the cited registration." The examining attorney then compared a portion of applicant's Class 9 identification with the identification in the cited PROJECTLINK registration, and concluded that these software items "appear to be used for business and engineering project management. Applicant has made no distinction between the goods. Even if the goods do not perform the same exact function, they appear to be used in the same field, and therefore, confusion as to the source of the goods is likely." In his conclusion, the examining attorney repeated his assessment that the "goods of the parties perform a highly similar function and, at least, are used in the same field." Applicant's reply brief focused solely on the marks.

From this review, it can be seen that the examining attorney, at best, can be said to have included applicant's two service classes in the refusal of registration by a single reference in the final refusal. Even then, the examining attorney did not specifically discuss the nature of the purported relationship between applicant's services and the goods in the cited registration. Because applicant never discussed whether its services are or are not related to the goods in the cited registration, it is not clear

that the examining attorney's single cursory reference was sufficient to put the applicant on notice that the refusal of registration encompassed all three classes of goods and services in the application.

Ultimately, we need not decide whether the refusal of registration encompassed applicant's service classes. We find that the examining attorney waived or withdrew any presumptive refusal as to those classes when he failed to address in his appeal brief the relationship, if any, of applicant's services and the goods in the cited registration. Accordingly, we have before us on appeal only the question whether applicant should be refused registration as to its Class 9 goods; the application shall proceed at least in regard to the service classes.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the overlapping nature of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the marks, the examining attorney contends that the WINDCHILL portion of applicant's mark is merely a "house mark" and that applicant has appropriated the registered mark and merely added this house mark. The basis for the argument is applicant's acquisition of the WINDCHILL mark from Windchill Technology, Inc. and applicant's purported filing of numerous applications for marks featuring WINDCHILL as the first term.

The examining attorney did not raise the issue of applicant's various pending "WINDCHILL \_\_\_\_" applications until he referenced them in his appeal brief, noting therein that the applications were not available when the final refusal was made. Applicant, however, implicitly admits that WINDCHILL originally was a house mark or trade name, because it states in its reply brief that WINDCHILL "had its origin in the name of an acquired company that has been integrated into Applicant's operations." Moreover, applicant acknowledges that the applications for various WINDCHILL marks are pending, insofar as it disputes the examining attorney's house mark argument and asserts that WINDCHILL is a product mark used on or in connection with various products by coupling WINDCHILL with "a variety of descriptive or heavily suggestive terms appropriate to different software products."



Applicant and the examining attorney appear to argue the issue to support their respective views of what is the "dominant" term in applicant's mark. Applicant argues that the dominant term is WINDCHILL, because PROJECTLINK is descriptive or highly suggestive. The examining attorney argues that PROJECTLINK is dominant because WINDCHILL is a house mark.

We agree with the examining attorney that the WINDCHILL portion of applicant's mark will be perceived as a house mark or trade name, because applicant has coupled it with a variety of other terms. The various composites may very well be perceived as product marks, but the WINDCHILL element will be perceived as the house mark or trade name that it was prior to applicant's acquisition of the company that bore the name.

An applicant cannot normally avoid a finding of likelihood of confusion, when marks are used on or in connection with similar products, by adopting as a mark that which merely combines a house mark or trade name with an already registered term. *See, e.g., In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE for clothing held likely to be confused with CREST CAREER IMAGES for uniforms); and *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive

service stations refused registration because likely to be confused with ACCUTUNE for automotive testing equipment).

Applicant has argued that the registered mark PROJECTLINK is highly suggestive (and has intimated that it may even be descriptive) and should be accorded a limited scope of protection. Of course, to the extent that applicant is alleging that registrant's mark is descriptive or non-distinctive and therefore unregistrable, this would be an impermissible collateral attack on the registration. See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Such allegations are properly raised only in the context of a petition to cancel the registration. Even if we consider applicant's argument to be one asserting only that the registered mark is suggestive, "even weak marks are entitled to protection against registration of similar marks" for related goods or services. *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982). See also, *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

Inherent in applicant's argument that PROJECTLINK is suggestive is an acknowledgment that the term has the same

connotation when used by applicant and registrant, i.e., that the term suggests software that allows users to link aspects of their projects. A consumer familiar with registrant's PROJECTLINK brand computer programs, when confronted with applicant's WINDCHILL PROJECTLINK products and services, may conclude that these are a new or expanded line stemming from registrant's initial program.

Turning then to the goods, we agree with the examining attorney that certain of applicant's computer software products may be the same as, and certainly would have to be considered closely related to, the software program identified in the cited registration. The latter covers a "computer software program ... used to generate and update project management plans from business and engineering process models." Applicant's products include "computer software for workflow, process and production automation" and "computer software for information management of business, organizational, supplier, engineering, component, product, production and maintenance information." Any differences between the programs of applicant and the registrant, not reflected in the identifications, are irrelevant to our analysis, as are any differences in channels of trade. See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d

1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Under these circumstances we find that confusion will be likely when applicant uses its mark for its goods.

Decision: The refusal of registration is affirmed as to the Class 9 goods but is found to have been waived or withdrawn as to the Class 41 and 42 services.